

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

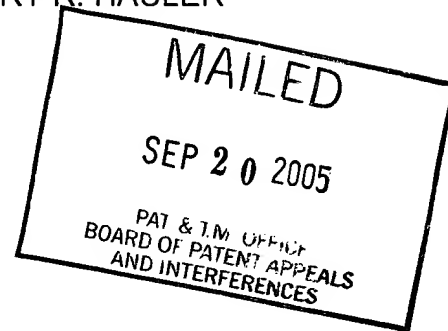
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LEE A. CHASE, ELDEAN WEIDMAYER and GREGORY R. HAULER

Appeal No. 2005-1698
Application No. 09/775,425

ON BRIEF



Before FRANKFORT, NASE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 8-11, 13-20, 22-25, 27 and 28. Claims 7, 12, 21 and 26 have been cancelled.

BACKGROUND

The appellants' invention relates to a wheel and overlay assembly. A significant feature of the appellants' invention is that the peripheral lip of the overlay has a radially outermost edge aligned within a predetermined margin of the radially outermost edge of the flange lip of the wheel such that the peripheral lip of the overlay cannot extend

radially beyond the outermost edge of the flange lip of the wheel regardless of tolerance variations of the overlay and the wheel. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The Applied Prior Art

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Todd	5,143,426	Sep. 1, 1992
Beam	5,368,370	Nov. 29, 1994
Chase et al. (Chase)	5,564,791	Oct. 15, 1996
Murray et al. (Murray)	5,842,750	Dec. 1, 1998

The Rejections

The following rejections are before us for review.¹

Claims 1, 10 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Todd.

Claims 1, 4, 5, 10, 11, 15, 18-20, 24 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Beam.

Claims 1, 4, 6, 8, 11, 13-15, 18, 20, 22, 25, 27 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Chase.

Claims 1-3, 9, 11, 15-17, 23 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Murray.

¹ The rejections based on Eikhoff, Buerger and Maloney have been withdrawn (answer, page 3).

Claims 2, 3, 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Todd.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed November 5, 2002) and corrected answer² (mailed May 21, 2004) for the examiner's complete reasoning in support of the rejections and to the brief (filed May 5, 2003) and reply brief³ (filed October 3, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

² The examiner issued a corrected answer on May 21, 2004 in response to an administrative remand by the BPAI objecting to the examiner's failure to list the prior art references cited in the answer mailed July 28, 2003.

³ Per appellants' request in the reply filed July 23, 2004, the reply brief filed October 3, 2003 is considered as appellants' reply to both the answer mailed July 28, 2003 and the corrected answer mailed May 21, 2004.

The rejections based on Todd

The examiner has rejected claims 1, 10 and 11 as being anticipated by Todd. Todd discloses a vehicle wheel construction comprising a wheel 10 provided with an ornamental cover 22 comprising a foam core base material 24 and a decorative fascia 26 molded over the base material 24. The fascia 26 and base 24 are molded such that the openings 28 corresponding to the vent openings 20 of the rim 12 of the wheel 10 and bores 30 corresponding to the bolt holes 16 of the wheel are formed to provide the required access. The mechanical lock of the fascia 26 around the base 24 to the rim 12 is formed through the vent openings 20 by molding the thermoplastic around the edges of the openings 20. A flanged lip 32 is formed to secure the fascia 26 to the wheel. For added securement, the lip 32 may also be formed around the bolt holes 26. As a result of this mechanical attachment, no adhesive is required. According to Todd, in a preferred embodiment, "the peripheral edge 34 of the fascia 26 extends to the edge of the wheel" (column 3, lines 35-36).

The appellants argue, in essence, that Todd's fascia 26 does not have "a radially outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel," as called for in claim 1, because Todd fails to appreciate the criticality of the fascia not extending radially beyond the outermost edge of the wheel. Thus, according to the appellants, Todd's disclosure of a

wheel cover designed to extend to the radial edge of the rim implicitly allows for the wheel cover to extend radially beyond the edge of the rim due to tolerance variations (brief, page 10).

The appellants' argument that Todd's disclosure of the peripheral edge of the fascia extending to the edge of the wheel allows for the fascia to extend radially beyond the rim due to tolerance variations presumes that one of ordinary skill in the art would design the wheel assembly disclosed by Todd with tolerance margins which permit such. Even assuming that Todd's disclosure would convey to one of ordinary skill in the art that the wheel assembly should be manufactured with tolerances that permit the fascia to extend radially beyond the edge of the wheel, Todd explicitly discloses a wheel assembly wherein the peripheral edge 34 of the fascia extends to the edge of the wheel. As such, the explicit instruction of Todd is to manufacture a wheel assembly which meets the claim limitation at issue. That, in the real world of manufacturing, one of ordinary skill in the art following the teachings of Todd might manufacture some wheel assemblies wherein the peripheral edge 34 of the fascia falls slightly within the peripheral edge of the wheel, some wherein the peripheral edge 34 of the fascia extends precisely to the edge of the wheel and still others wherein the peripheral edge 34 extends somewhat beyond the edge of the wheel, the first two groups falling within the scope of the claim and the third group falling outside the scope of the claim, in no way negates the fact that the wheel assembly disclosed by Todd meets the claim limitation.

This is not a case of incidental or accidental anticipation where one of ordinary skill in the art at the time of the appellants' invention would not have recognized that Todd's wheel assembly possesses the claimed feature argued by the appellants. On the contrary, given the explicit teachings of Todd, one of ordinary skill in the art would have immediately envisaged a wheel assembly wherein the peripheral edge of the fascia is aligned with the peripheral edge of the wheel, not a wheel assembly wherein the fascia extends beyond the peripheral edge of the wheel.

The appellants are correct that Todd does not express any appreciation of appellants' concern that the overlay not extend radially beyond the outermost edge of the wheel regardless of tolerance variations and thus does not disclose, at least expressly, designing the overlay with a margin of safety to ensure that permitted tolerance variations will not cause the overlay (fascia) to extend radially beyond the edge of the wheel. The appellants' claims, however, are directed to a product, namely, a wheel and overlay assembly, not to a method of manufacturing a wheel and overlay assembly. The patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). As already noted above, a wheel assembly wherein the peripheral edge of the overlay or fascia extends to the edge of the wheel, in accordance with the specific

teachings of Todd, meets the claim limitation at issue, regardless of whether it was manufactured in a manner in which precautions were taken to ensure such.

For the foregoing reasons, the appellants' arguments are not persuasive of any error on the part of the examiner in rejecting claim 1 as being anticipated by Todd. The appellants have not argued the like rejection of dependent claims 10 and 11 apart from claim 1, thus permitting these claims to stand or fall with representative claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)). The rejection of claims 1, 10 and 11 as being anticipated by Todd is sustained.

The appellants' argument with respect to the rejection of claims 2, 3, 8 and 9 as being unpatentable over Todd is based on the same argument discussed above with respect to claim 1 and is likewise unpersuasive with regard to the subject matter of claims 2, 3, 8 and 9. The appellants' additional statement on page 17 of the brief that the teachings of Todd are "completely contrary " to the structure of appellants' preferred embodiment because Todd teaches that "the fascia material may be extended completely around the base material 24 to completely enclose the material" (column 3, lines 39-41) is not well taken. This disclosure of Todd is directed not to the wheel construction, wherein the component at issue comprises openings, as discussed above, but to other components, such as dashboards or instrument panels, which do not include openings. The rejection of claims 2, 3, 8 and 9 is sustained.

The rejections based on Beam, Chase and Murray

The appellants' only mention of these references in the brief is that "[n]one of the Examiner's cited references, including [Beam, Chase and Murray] disclose a peripheral lip of a wheel cover having a radially outermost edge located within a predetermined margin of the radially outermost edge of a wheel, and in fact none even discuss such a predetermined margin" (brief, pages 7-8). The subsequent discussion in the appeal brief indicates that the appellants are relying on the same line of argument discussed above with regard to the rejections based on Todd. For the reasons discussed above, and for the additional reasons which follow, this argument is likewise unpersuasive with regard to the disclosures of Beam, Chase and Murray. The rejections of claims 1, 4, 5, 10, 11, 15, 18-20, 24 and 25 as being anticipated by Beam, claims 1, 4, 6, 8, 11, 13-15, 18, 20, 22, 25, 27 and 28 as being anticipated by Chase and claims 1-3, 9, 11, 15-17, 23 and 25 as being anticipated by Murray are thus sustained.

Beam discloses a vehicle wheel construction comprising a wheel provided with an outer rim flange 14 having an annular catch 46 formed thereon. As illustrated in Figure 5 and discussed in the last paragraph in column 5, "[a] peripheral edge 48 of the outer connecting portion 36 of the applique 34 engages the annular catch 46 to hold the applique 34 in place while the adhesive 42 cures." It is quite apparent from this disclosure, as well as the illustration in Figure 5, that the peripheral edge 48 of the applique is expressly and specifically designed to extend within a margin of the radially outermost edge of the outer rim flange 14 of Beam's wheel and thus, in accordance

with the teachings of Beam, cannot extend radially beyond the outermost edge of the wheel regardless of tolerance variations of the applique and the wheel without destroying the function of the annular catch 46.

Chase discloses a wheel and overlay assembly wherein the wheel 110 is provided with a flange lip 120 and the overlay is provided with an overlay lip 122a. As seen in Figure 1, the radially outermost edge of the overlay lip 122a extends within a margin of the radially outermost edge of the flange lip 120, with both having a curved edge configuration to permit a conventional weight clip 130 to be placed around the flange lip and overlay lip. One of ordinary skill in the art reading Chase's disclosure would have understood that an overlay lip extending radially beyond the flange lip of the wheel would interfere with the placement of the weight clip thereover and that such was not intended by Chase.

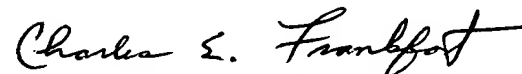
Murray discloses a composite wheel having a decorative overlay 3 molded thereon, the overlay including a portion 13 which extends over edge 9 of the outermost flange 30 of rim portion 21 of the wheel. As illustrated in Figure 3 and as is evident from Murray's discussion of the process and apparatus for molding the overlay material onto the wheel backbone 2, the molding apparatus and process, wherein the radially outermost side 39 of edge 9 of the wheel is placed against the forming surface 8 of the apparatus (see Figure 12), ensures that the overlay portion 13 will not extend radially beyond the radially outermost side of the wheel.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6, 8-11, 13-20, 22-25, 27 and 28 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

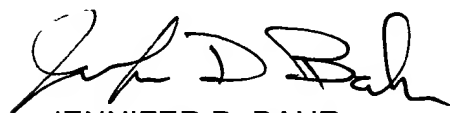
AFFIRMED



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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